

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of
Chiu, et al.
Serial No. 07/525,943
Filed: May 17, 1990
For: BULKING AGENTS AND PROCESSES FOR
PREPARING THEM FROM FOOD GUMS

Group Art Unit: 132
Examiner: Joseph Golian

Commissioner of Patents and Trademarks
Washington, D. C. 20231

Sir:

AFFIDAVIT UNDER 37 C.F.R. SECTION 1.131

State of New Jersey)
)
County of Somerset) ss

We, Dr. Chung-Wai Chui, Matthew J. Henley and James P. Zallie, being duly sworn, depose and say that:

1. We are named inventors of the above-captioned patent application and inventors of the subject matter described and claimed in Claims 29-35 therein. We have reviewed the Office Action, dated September 9, 1991, in the above-captioned patent application.

2. We make this affidavit to antedate the references: U.S. Patent No. 4,971,814, filed December 29, 1989 and issued November 20, 1990 to Tomita, et al.; European Patent Application Publication No. 0,359,075, published March 21, 1990 by Schnepp, et al.; and International Application Published Under the Patent Cooperation Treaty, Publication No. WO 91/11112, published August 8, 1991, by Whistler, claiming a U.S. priority filing of January 24, 1990, under U.S. Serial No. 469,153, which have been brought to the Examiner's attention in the above-captioned application.

3. Prior to December 29, 1989, we had completed our invention as described and claimed in the subject application in this country, as evidenced by the following:

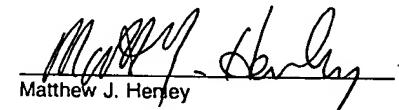
a. Prior to December 29, 1989, under the direction of Matthew J. Henley, a technician, Dana Janik, prepared depolymerized food gums having a DP of about 3 to 75, as evidenced by the copy of Laboratory Notebook Page Nos. 134 and 137 of Laboratory Notebook No. 6231, which pages are attached hereto as Exhibit A. Under the direction of Matthew J. Henley, the depolymerized food gums were subsequently tested for reducing sugar content, viscosity in solution and molecular weight as evidenced by the copy of laboratory Notebook Page No. 8 of Laboratory Notebook No. 6698 and the copy of a two page

summary of gel permeation chromatography test results which pages are attached hereto as Exhibit B.

b. Prior to December 29, 1989, under the direction of James P. Zallie, a chemist, Paul Vjada, prepared cakes containing depolymerized food gums (tamarind, guar gum and locust bean gum) having a DP of about 3 to 75 as a bulking agent in lieu of part of the sucrose normally contained in the cakes, and tested the functional and organoleptic qualities of the cakes, as evidenced by the copy of Laboratory Notebook Page No. 25 of Laboratory Notebook No. 6616, which page is attached hereto as Exhibit C.

4. Each of the dates have been purposely deleted from Exhibits A, B and C.


Dr. Chung-Wai Chiu


Matthew J. Henley


James P. Zallie

National Starch and Chemical Company
P. O. Box 6500
Bridgewater, New Jersey 08807

February 4, 1992

Country:	United States of America)	
State:	New Jersey)	ss:
County:	Middlesex)	

On this 4th day of February, 1992, before me personally appeared Dr. Chung-Wai Chiu, Matthew J. Henley and James P. Zallie, to me known and known to me to be the person mentioned in and who executed the foregoing document; and he duly acknowledged to me that he executed the document for the uses and purposes therein set forth.

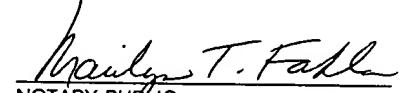

NOTARY PUBLIC
MARILYN T. FAKLA
NOTARY PUBLIC OF NEW JERSEY
My Commission Expires July 18, 1993

EXHIBIT A

1358

1151



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 12

MAILED: September 30, 1991

In re application of
Chung-Wai Chiu et al.
Serial No. 07/525,943
For: BULKING AGENTS AND PROCESSES : Decision on Petition
FOR PREPARING THEM FROM FOOD :
GUMS :

Applicants have filed a petition on September 24, 1991, under 37 CFR 1.181, requesting supervisory intervention regarding the examiner's denial of the conversion request to correct the inventorship, under 37 CFR 1.48(a), filed April 19, 1991. The examiner issued an Office action on September 4, 1991 denying the conversion on the basis that claims directed to the invention to which the proposed additional inventor, Roger Jeffcoat, contributed were no longer present in the application. It is noted that, but for the absence of claimed subject matter to which Jeffcoat contributed, the conversion request would have been otherwise approved by the examiner.

It should be noted that the PTO was directed by applicants, subsequent to April 19, 1991 but prior to the time the examiner took the case up for further action, to cancel the only claims in the application which included the contribution of proposed inventor Jeffcoat. Petitioner argues that the examiner erred in that the entry should have been approved since, at the time of filing thereof, both sets of claims were still present. Petitioner further indicates that the inventors would be disadvantaged, if the decision of the examiner were to stand unchanged, by virtue of their foreign filings which depend upon this case for foreign priority and which name Jeffcoat as one of the coinventors thereof.

Upon a thorough consideration of the facts, I find that the examiner was not incorrect in his denial of the conversion of inventorship on the basis of the claimed subject matter as it existed at the time of the action on September 4, 1991. It is noted that had the examiner approved the conversion, it would have created an anomalous situation of approval immediately followed by a requirement to amend the inventorship under 37 CFR 1.48(b). The latter requirement would have been necessitated by the cancellation of all claims directed to the contribution of inventor Jeffcoat. It is noted, however, that continued denial of the conversion might inequitably harm applicants.

TELETYPE TRANSMISSION

Accordingly, this petition is being decided on the basis of the state of the application at the time that the original conversion request was received by the Office, and as such, is granted. Applicants are required, however, to file a petition under 37 CFR 1.48(b) to remove Jeffcoat as an inventor in view of the absence of claims directed to his inventive contribution and to avoid the necessity of making a 35 USC 102(f) rejection of all of the claims remaining in the application.

PETITION GRANTED.



Barry S. Richman, Director
Patent Examining Group 130
Specialized Chemical Industries
and Chemical Engineering

Edwin M. Szala
National Starch and Chemical Co.
Box 6500
Bridgewater, NJ 08807

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of :
 Chiu, et al. :
 Serial No. 07/525,943 : Group Art Unit: 132
 Filed: May 17, 1990 : Examiner: Joseph Golian
 For: BULKING AGENTS AND PROCESSES FOR
 PREPARING THEM FROM FOOD GUMS

PETITION FOR EXTENSION OF TIME

Commissioner of Patents and Trademarks
 Washington, D. C. 20231

SIR:

Applicant requests that the time for taking action in this case be extended pursuant to 37 CFR 1.136(a) for:

one month three months
 two months four months

The fee set in 37 CFR 1.17 for the extension of time is \$350.00

Fee enclosed. Please charge any additional fee to Deposit Account No. 14-0455. A duplicate copy of this paper is enclosed.

Charge fee to Deposit Account No. 14-0455. Please charge any additional fee to Deposit Account No. 14-0455. A duplicate copy of this paper is enclosed.

Also enclosed:

Response Notice of Appeal Appeal Brief
 Section 1.48(b) Petition, Supplemental Information Disclosure Statement, Affidavit 37 CFR Section 1.131, PTO Form 1449 and References

Respectfully submitted,

Mary E. Porter

Mary E. Porter, Reg. No. 33,440
 Attorney For Applicant(s)
 Tel. No. 908-685-5127

National Starch and Chemical Company
 P. O. Box 6500
 Bridgewater, New Jersey 08807

Date: February 4, 1992

I HEREBY CERTIFY THAT THIS CORRESPONDENCE
 IS BEING DEPOSITED WITH THE UNITED STATES
 POSTAL SERVICE AS FIRST CLASS MAIL IN AN
 ENVELOPE ADDRESSED TO: COMMISSIONER OF
 PATENTS AND TRADEMARKS, WASHINGTON, D. C.
 20231, ON February 4, 1992
 BY Mary E. Porter

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of
Chiu, et al.
Serial No. 07/525,943
Filed: May 17, 1990
For: BULKING AGENTS AND PROCESS FOR
PREPARING THEM FROM FOOD GUMS
Group Art Unit: 132
Examiner: Joseph Golian

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT
PURSUANT TO 37 C.F.R. SECTION 1.99

Commissioner of Patents and Trademarks
Washington, D. C. 20231

Sir:

International Application Published Under the Patent Cooperation Treaty Publication No. WO 91/11112, published August 8, 1991, by Whistler, claims a priority filing of January 24, 1990, in the United States under U.S. Serial No. 469,153. Whistler discloses a method for making foods having reduced calorie content wherein up to 60% of the carbohydrate and up to 25% of the fat is replaced with an enzymatic hydrolysate of tamarind polysaccharide, having a DP of 7 and/or a DP of 9. Whistler also discloses a method for making a non-caloric substitute for food components, wherein a non-digestible hydrolysate of tamarind polysaccharide is treated to remove oligosaccharides and other saccharides having a DP of less than 6. Whistler also discloses processed foods having reduced calorie content wherein an oligosaccharide having a DP of 7 that has been derived from the enzymatic hydrolysis of tamarind polysaccharide is used in the food. Whistler makes no disclosure with respect to hydrolyzed polysaccharides from sources other than tamarind. Applicants' invention was completed before the U.S. priority date indicated in the Whistler publication.

Japanese Patent Application Publication No. 210965/87, published September 17, 1987, by Shokuhin Sangyo Bioreactor System, discloses a low calorie beverage and food and a process for producing these items. The low calorie beverage and food comprises an oligosaccharide, having a DP of 2 to 30 that is derived from agar by hydrolysis with an enzyme.

U.S. Patent No. 3,480,511, issued November 25, 1969, to Jones, discloses a method for enzymatic degradation of tamarind seed polysaccharide using a proteolytic enzyme. The degraded polysaccharide is taught to be useful in the oil drilling industry and in the preparation of gelling agents. U.S. Patent No. 3,399,189, issued August 27, 1968, to Gordon, discloses a method for recovering polysaccharides from tamarind seed.

The disclosure of the above references does not constitute an admission that they are relevant or material to the claims or are "prior art" to the subject application. The citation of them is not to be construed as a representation that no better art exists or that a search has been made, they are cited merely as constituting collectively the closest art of which the Applicants are aware.

Respectfully submitted,

Mary E. Porter

Mary E. Porter, Reg. No. 33,400
Attorney for Applicants
Tel. No. 908-685-5127

National Starch and Chemical Company
P. O. Box 6500
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February 4, 1992

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BY Mary E. Porter

Form PTO-1449 (REV. 7/80)		U.S. Department of Commerce Patent and Trademark Office		Atty. Docket No. #1358		Serial No. 07/525,943	
LIST OF REFERENCES CITED BY APPLICANT (Use several sheets if necessary)		Applicant Chiu, et al.					
		Filing Date May 17, 1990		Group 132			
U.S. PATENT DOCUMENTS							
*Examiner Initial		Document Number	Date	Name	Class	Subclass	Filing Date if Appropriate
	AA	3,399,189	8/27/68	Arthur L. Gordon	260	209	
	AB	3,480,511	11/25/69	Duane A. Jones	195	31	
	AC						
	AD						
	AB						
	AF						
	AG						
	AH						
	AI						
	AJ						
	AK						
FOREIGN PATENT DOCUMENTS							
		Document Number	Date	Country	Class	Subclass	Translation
	AL	WO 91/11112	8/8/91	PCT			
	AM	210965/87	9/17/87	Japan			X
	AN						
	AO						
	AP						
OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, Etc.)							
	AR						
	AS						
EXAMINER				DATE CONSIDERED			
<small>*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.</small>							